



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: :
:
Bruce A. Rogers, et al. :
:
Application No.: 10/764,237 : Group Art Unit: 3732
:
Filed: January 23, 2004 : Examiner: R.K. Doan
:
For: ADJUSTABLE HAIR HOLDING :
DEVICE :
:
Atty. Docket No.: ROG030.10005 :
:

I, John F. Letchford, Registration No. 33,328, certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on August 13, 2008.

John F. Letchford

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

APPELLANTS' BRIEF PURSUANT TO 37 CFR §§ 41.31 and 41.37

The above-identified application comes before the United States Patent and Trademark Office ("USPTO") Board of Appeals and Interferences ("Board") from a Final Rejection of claims 1 and 3-15 dated May 14, 2008.

I. REAL PARTY IN INTEREST

The real party in interest in the present appeal is Bruce A. Rogers, 325 S. Camac St., #3F, Philadelphia, PA 19107, USA,

as evidenced by an assignment of the entire right, title and interest in and to the application from the co-inventor, David Livingston, to Mr. Rogers, which is recorded in the USPTO at reel 015084 and frame 0299.

II. RELATED APPEALS AND INTERFERENCES

Substantially concurrently herewith, Appellants have filed or will file an appeal in United States Patent Application No. 10/763,846 which may directly affect or be directly affected by or may have a bearing on the Board's decision in the presently pending appeal.

III. STATUS OF THE CLAIMS

The status of the claims in the application is as follows:

Claim 2 has been canceled. Claims 8-10 have been withdrawn from consideration. Claims 1, 3-7 and 11-15 remain in the application and are finally rejected.

IV. STATUS OF AMENDMENTS FILED SUBSEQUENT TO THE FINAL REJECTION

No amendments were filed subsequent to the Final Rejection.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

Most broadly, the invention defined in the claims on appeal is addressed to a hair holding device in which a first body member and a second body member are hingedly connected and are operable to grippingly engage a quantity of gathered hair strands. The claims on appeal include one (1) independent claim, claim 1.

The apparatus recited in independent claim 1 on appeal involves (with reference to specification page and line numbers and drawing reference characters, where available, in parentheses):

a first body member and a second body member (specification at page 8, lines 13-17 and page 13, lines 27-31; drawing ref. nos. 112, 212, 114, 214), said first and second body members comprising hair gripping portions (specification at page 8, lines 17-20 and page 13, lines 31-34; drawing ref. nos. 122, 124, 222, 224) adapted to be squeezed by a user whereby said hair gripping portions come into contact with gathered strands of a user's hair;

hinge means (specification at page 8, lines 13-17 and page 13, lines 27-31; drawing ref. nos. 116, 216) for pivotally connecting said first and second body members; and

adjustment means comprising a slip friction mechanism coaxially arranged with respect to said hinge means (specification at page 8, line 28 through page 15, line 17; drawing ref. nos. 136, et seq. and 236, et seq.) for causing said hair gripping portions to remain at a point at which said hair gripping portions are squeezed together by a user.

Claims 3-7 and 11-15 on appeal further enlarge upon the structure of the hair holding device of claim 1 to define various features which are believed to be representative of preferred aspects thereof.

Presently existing hair holding device assume a wide variety of configurations. Several of these designs were discussed at length in the specification of the present application as well as during prosecution thereof. Regardless of

their individual constructions, indeed, because of their structural peculiarities, none of these devices, including the hair holding devices and other apparatus disclosed in the references cited against the claims on appeal, is capable of producing the advantages afforded by the claimed invention now before the Board.

VI. GROUND OF OBJECTION/REJECTION TO BE REVIEWED ON APPEAL

A statement of each separate ground of objection or rejection Appellant wishes to be reviewed, including the basis of each ground of rejection is as follows:

(1) Claims 1 and 3-7 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Wilde (U.S. Patent No. 870,330).

(2) Claims 1, 3-7 and 11 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Sheehan (U.S. Patent No. 3,546,750).

(3) Claims 1, 3 and 12-15 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Rizzuto (WO 02/058504).

VII. ARGUMENT

(1) Rejection of Claims 1 and 3-7 under
35 U.S.C. § 102(b) as being anticipated by Wilde

Claims 1 and 3-7 stand finally rejected under 35 U.S.C. § 102(b) as being anticipated by Wilde. Such rejection is respectfully traversed.

In regard to Wilde, Appellants initially note -- as they have in the past -- that the Wilde device is an ear ring. It is not a hair holding device. As explained below, it would be essentially useless in holding a lock or shock of hair.

Simple inspection of FIGS. 1 and 5 of the Wilde patent reveals that the opposed convex "dished ends" 7 and 11 of spring frame "a" and clamping member "b", which together apply clamping force to retain the ear ring on a user's ear, present very small cooperative clamping surface areas, i.e., areas sufficient to clamp a user's ear lobe. Even assuming such surfaces were as large as those shown in FIG. 5 of Wilde (which they very likely would not be in practical use), and if they were attempted to be used to clamp a wearer's hair, they would clamp little more than a few strands of hair at the centralmost portions of the clamping surfaces. As a result, even if somehow adapted to a hair holding device, such a clamping arrangement would very likely quickly become disengaged from and fall from the user's hair.

Moreover, the hair holding device of Appellants' claim 1 specifically calls for hair gripping portions as being part of the first and second body members. The Examiner's final statement of rejection in reliance upon Wilde is -- as it has always been -- conspicuously silent regarding the presence of any *hair gripping portions* in the Wilde device. As such, the ear ring taught by Wilde does not anticipate the invention defined in Appellants' claim 1.

Furthermore, Appellants kindly submit that it would be legally improper hindsight to assert that it would have been obvious at the time of Appellants' invention to adapt the teachings of Wilde to hair holding device technology to produce a hair holding device having a slip friction adjustment means as prescribed in Appellants' claim 1. In this regard, the Examiner will note that the Wilde patent issued in 1907. In the 100 years

since, as reflected not only the Wilde patent but also in the other references cited by the Examiner as being of interest, none have proposed the use of a slip friction adjustment means outside of the ear ring art. In other words, inventors have had a century since issuance of the Wilde patent to conceive of a hair holding device including a slip friction adjustment means. None have done so. This fact is compelling testament to the non-obviousness of Appellants' invention.

In the **Response to Arguments** section at page 5 of the Final Office Action the Examiner stated the following (with emphasis added):

In response to Applicant's argument that Wilde's device is not a hair holding device; Applicant is noted that such recitation *recites in the preamble* and Wilde has shown all the claimed structures in the body of the claim; therefore, the preamble is not given patentable weight. Also, Applicant has argued that the clamping surface areas of the device are very small, and if they were attempted to clamp the hair of the user, they would clamp a few strands of hair; such arguments show that the clamping surface areas of Wilde are capable to hold the hair of the user, *how much of hair being retained within the clamping surface areas are subjected to the type of the user's hair (thick or thin)*.

Appellants address these specific contentions below.

First, Appellants kindly direct both the Examiner's and the reviewing members of the Board's attention to the hair holding structure in the body of claim 1 on appeal specifically defining the hair holding device called for in the preamble thereof. See, for example, the first and second body members comprising hair gripping portions adapted to be squeezed by a user whereby said hair gripping portions come into contact with gathered strands

of a user's hair. It is these structural "hair gripping portions" of the present hair holding device invention -- in the body of claim 1 -- which saliently distinguish the present invention from the ear ring of Wilde, as elaborated below. Thus, Appellants neither rely nor attempt to rely on the preamble to make this all-important distinction.

Second, the Examiner appears to be suggesting -- for the first time -- that the ability, if any, of the Wilde ear ring to be used as a hair holding device *is a function of the width of the user's hair (thick or thin)*. Not only is this argument pure conjecture entirely unsupported by any teaching in Wilde, it simply ignores the practical fact that the opposed convex "dished ends" 7 and 11 of spring frame "a" and clamping member "b" of the Wilde ear ring, even if they were somehow attempted to be used to clamp a wearer's hair, would clamp little more than a few strands of hair at the centralmost portions of the clamping surfaces -- regardless of whether such hair were "thick" or "thin."

Appellants reiterate that the Wilde device does not in fact satisfy the structural limitations of the presently claimed invention. Once again, the small convex clamping surfaces of spring frame "a" and clamping member "b" of Wilde could not possibly engage enough hair to retain the device on a shock of hair. Consequently, under no reasonable interpretation of the Wilde patent could they be considered to be hair gripping portions of first and second members of a hair holding device. Thus, the Wilde device does not anticipate, suggest or otherwise render obvious the hair holding device defined in Appellants' claim 1.

Accordingly, Appellants kindly submit that the outstanding rejection of claims 1 and 3-7 under 35 U.S.C. 102(b) as being anticipated by Wilde is improper and should be reversed.

(2) Rejection of Claims 1, 3-7 and 11 under
35 U.S.C. § 102(b) as being anticipated by Wilde

Claims 1, 3-7 and 11 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,546,750 to Sheehan. Such rejection is respectfully traversed.

The Sheehan device is a one-way gripping device (specifically, a cable tie) for permanently gripping strands, cables, wires and the like (see col. 1, lines 48-52). In fact, the curved arms 22 and 24 of the Sheehan device must be physically severed, thereby destroying the device, in order to remove it from the cables or like members about which it is bound (see col. 3, lines 15-19). The arms 22 and 24 of Sheehan are connected to a one-way ratchet mechanism that prevents reverse rotation of the arms (see col. 1, lines 24-27; col. 3, lines 3-14, lines 20-26 and lines 42-51; and col. 4, lines 1-4). Such a one-way gripping mechanism is the antithesis of the slip friction mechanism particularly recited in Appellants' claim 1 and described in Appellants' specification which purposely does permit reverse rotation of the hair gripping members. Consequently, Sheehan does not anticipate the invention defined in Appellants' claim 1.

In the **Response to Arguments** section at page 5 of the Final Office Action the Examiner stated the following in respect to Sheehan (with emphasis added):

Applicant has further argued that the claims are structurally distinguishable from the Sheehan device, however, Applicant fails to point out which elements of Sheehan result structural difference than the claimed invention.

With due respect, neither Appellants nor the undersigned can appreciate the Examiner's suggestion in this regard. It appears the Examiner is intimating that since Appellants' claims, which are already plainly structurally distinguishable from the Sheehan device, do not expressly state that they are not a "Sheehan-type device," then Sheehan anticipates their structure. More specifically, it seems the Examiner is suggesting that the claims of the present application must expressly state that the instant hair holding device is not a one-way gripping device such as in Sheehan, a device which must be destroyed after each use -- an unthinkable impracticality for a reusable hair holding device -- for Appellants' claims to be considered to be distinguishable from the Sheehan device. People simply do not wear cable ties or other permanently fixed devices on their hair. With due respect, any fair and reasonable reading of Appellants' specification and the Sheehan patent clearly belies this fallacy.

Accordingly, reversal of the outstanding section 102(b) rejection of claim 1 and its dependent claims 3-7 and 11 in reliance upon Sheehan is respectfully requested.

- (3) Rejection of Claims 1, 3-7 and 12-15
under 35 U.S.C. § 102(b) as being
anticipated by WO 02/058504 to Rizzuto

Claims 1, 3-7 and 12-15 stand rejected under 35 U.S.C. § 102(e) as being anticipated by WO 02/058504 to Rizzuto. Such rejection is respectfully traversed.

But for a concealed spring assembly, Rizzuto teaches a conventional spring-biased hair clip of the type described at length in Appellants' specification from which the presently claimed invention represents a significant and patentable departure. Rizzuto contains no disclosure of adjustment means comprising a "slip friction mechanism" as described in Appellants' specification and as recited in Appellants' claim 1. In addition, the hair gripping portions 18 of the Sheehan device are not adapted to be squeezed by a user. They are biased into hair-gripping engagement with a user's hair under the influence of tension spring 26. As a result, the hair gripping portions 18 do not cooperate with a slip friction mechanism-containing adjustment means to cause the hair gripping portions to remain at a point at which said hair gripping portions are squeezed together by a user as mandated by Appellants' claim 1. Rizzuto thus does not anticipate the invention defined in Appellants' claim 1.

In the **Response to Arguments** section at page 5 of the Final Office Action the Examiner stated the following in respect to Rizzuto (with emphasis added):

Applicant has also argued that gripping portions (12,14) of Rizzuto are not adapted to be squeezed by a user; Gripping portions do adapt to be squeezed by a user via handle 30,32 (paragraph 23 of Rizzuto).

Other than a hidden torsion spring, Rizzuto is a conventional hairclip with squeezable handles. The handles, not the hair gripping portions are squeezed by the user. Appellants have exhaustively rebutted this argument above.

Accordingly, reversal of the outstanding section 102(b) rejection of claim 1 and its dependent claims 3-7 and 12-15 based on Rizzuto is respectfully requested.

Lastly, in the **Response to Arguments** section bridging pages 4 and 5 of the Final Office Action the Examiner stated the following in respect to the 37 CFR § 1.132 declarations of Ms. Rommy Revson and Ms. Mary Lafauci, which declarations were originally submitted in a Submission After Final Office Action dated December 18, 2007 prior to the February 22, 2008 Request for Continued Examination (RCE) of the present application and which were resubmitted with the RCE (with emphasis added):

The affidavit under 37 1.132 filed 2/26/08 is insufficient to overcome the rejection of claims 1, 3-7, 11-15 based on 102(b) rejections of Wilde, Sheehan and Rizzuto as set forth in the last Office action because:

Both declarations of Lafauci and Revson state that the claimed invention solved a problem that was long felt need in the art. *Applicant is noted that there is no objective evidence of one of an ordinary skill in the art were working on the problem for a long period of time without solution and if so, how*

long; also, the declarations fails to show objective evidence of nonobviousness which is commensurate in scope with the claims.

Ms. Rommy Revson and Ms. Mary Lafauci are persons of extraordinary if not unparalleled skill in the subject art. Their declarations -- although unnecessary to support patentability since, as noted above, Appellants' device is neither anticipated nor rendered obvious by Wilde, Sheehan or Rizzuto -- make it indisputably clear that the invention defined in Appellants' claims prescribes a hair holding device that effectively eliminates the well-known and long-standing problem of slippage associated with spring biased hair clip devices which, prior to Appellants' invention, has not been solved by the prior art.

As Ms. Revson and Ms. Lafauci unequivocally aver, they recognized but repeatedly tried and failed to solve the same long-standing problem addressed and solved by Appellants. *Markman v. Lehman*, 987 F. Supp. 25, 43, 45 USPQ2d 1385, 1399 (d. D.C. 1997), *aff'd*, 178 F.3d 1306 (Fed. Cir. 1998) (unpublished) ("Establishing a long-felt need requires a showing that others skilled in the art in fact perceived a need and that this perception persisted over a long period of time without resolution by the prior art")

Applicant Bruce Rogers is the inventor of U.S. Patent No. 6,276,369 for HAIR BAND SYSTEM WITH STORAGE AND DISPLAY DEVICE. Assuming the level of ordinary skill in the instant art to be, at the lowest, a typical consumer of hair fashion products, or at the highest, a hairdresser, fashion designer or the like (either of whom does not hold a patent, has not filed a

patent application or has not published articles related to the presently disclosed and claimed technology), then at least Applicant Bruce A. Rogers should be considered to be a person of "extraordinary skill in the art" against which a legal assessment of what might be considered obvious to a hypothetical person of "ordinary skill in the art" simply does not apply.

However, if Applicant Rogers is presumed to be of "ordinary skill in the art," and the level of "ordinary skill in the art" is to be presumed to that of one who holds a patent or has filed a patent application or has published articles relating to the presently disclosed and claimed technology, then Appellants' invention is still unobvious because others of this elevated "ordinary skill in the art", i.e., multiple patent holders Ms. Revson and Ms. Lafauci -- whose inventions have experienced tremendous commercial success -- have repeatedly tried and failed to satisfy the long-felt need successfully addressed by Appellants prior to Appellants' invention.

In short, Appellants earnestly believe that, through submission of the Declarations of Ms. Revson and Ms. Lafauci, Appellants have offered (1) more than ample "objective evidence" that persons of far more than ordinary skill in the art were working on the problem for a long period of time without solution; (2) Ms. Revson's indication that her efforts have been repeated and reach back to the 1980s and Ms. Lafauci's indication that hers have been over the course of several years; and (3) as required by the Examiner, both Ms. Revson's and Ms. Lafauci's declarations that specifically provide objective evidence of nonobviousness which is commensurate in scope with the claims:

13. Based on my review of the '237 application, I believe that a hair holding device constructed in accordance with the hair holding device as claimed in independent claim 1 of the '237 application, in particular -- a hair holding device having first and second body members pivotally connected via hinge means, and a slip friction adjustment means -- would produce a hair holding device whose hair gripping portions would firmly engage and not slip or fall from a shock of hair, and therefore would solve the long-standing and notorious slippage problem associated with conventional spring-biased hair clips described in paragraph 10.

Revson Declaration at Paragraph 13.

9. Based on my review of the '237 application, I believe that a hair holding device constructed in accordance with the hair holding device as claimed in independent claim 1 of the '237 application would produce a hair holding device able not only to increase the coefficient of friction among the individual strands comprising gathered hair but also to increase the coefficient of friction between the surface of the invention and the surface of the hair. As a result, the invention's hair gripping portions would solve not just one, but both, of the long-standing slippage problems described in Paragraph 7.

Lafauci Declaration at Paragraph 9.

Lastly, although to this point they have been wrongly dismissed, as a matter of law the declarations of Ms. Revson and Ms. Lafauci cannot be ignored by the Examiner. "When a patent applicant puts forth rebuttal evidence, the Board [of Appeals] must consider that evidence." 498 F.3d 1345, 1351 (Fed. Cir. 2007) (emphasis added).

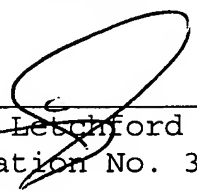
Appellants' invention satisfies a long-felt need that even those of extraordinary skill in the subject art could not fill prior to Appellants' solution. In this regard, the Declarations of Ms. Revson and Ms. Lafauci could not speak more forcefully and articulately to the nonobviousness of Appellants' invention.

To conclude, Appellant's claims must be interpreted fairly and accurately. Additionally, the teachings of the prior art cited against the claims on appeal must be fairly and accurately interpreted for what they in fact disclose and/or suggest. The disclosures of the cited references, when so interpreted, do not disclose or suggest Appellants' claimed invention. Particularly in light of Ms. Revson's and Ms. Lafauci's Declarations, the invention as a whole would not have been considered obvious to one skilled in this art at the time of Appellant's invention. Accordingly, it is respectfully submitted that the Final Rejection of claims 1 and 3-15 should be reversed.

Respectfully submitted,

BRUCE A. ROGERS, ET AL.

Date: August 13, 2008



John F. Letchford
Registration No. 33,328

Archer & Greiner
A Professional Corporation
One Centennial Square
P.O. Box 3000
Haddonfield, NJ 08033-0968
Tel.: (856) 354-3013
Fax: (856) 795-0574
E-mail: jletchford@archerlaw.com

VIII. APPENDIX

The claims on appeal are as follows:

1. A hair holding device comprising:

a first body member and a second body member, said first and second body members comprising hair gripping portions adapted to be squeezed by a user whereby said hair gripping portions come into contact with gathered strands of a user's hair;

hinge means for pivotally connecting said first and second body members; and

adjustment means comprising a slip friction mechanism coaxially arranged with respect to said hinge means for causing said hair gripping portions to remain at a point at which said hair gripping portions are squeezed together by a user.

3. The hair holding device of claim 1 wherein said slip friction mechanism comprises a first surface associated with said first body member, a second surface associated with said second body member, and biasing means for maintaining contact between said first and second surfaces such that a slip friction interface is created between said first and second surfaces.

4. The hair holding device of claim 3 wherein said slip friction interface extends perpendicular to said hinge means.

5. The hair holding device of claim 3 wherein at least one of said first and second surfaces is an irregular surface.

6. The hair holding device of claim 5 wherein at least one of said irregular surfaces is a toothed surface.

7. The hair holding device of claim 3 wherein said biasing means comprise a compression spring.

11. The hair holding device of claim 3 wherein at least one of said surfaces is provided on at least one insert carried by at least one of said first and second body members.

12. The hair holding device of claim 1 further comprising means for biasing said hair gripping portions into a predetermined position.

13. The hair holding device of claim 12 wherein said means for biasing comprise a torsion spring having a first end in contact with said first body member and a second end in contact with said second body member.

14. The hair holding device of claim 13 wherein said first and second body members further comprise handle portions that are squeezable by a user to release said hair gripping portions from the point at which said hair gripping portions are squeezed together by a user, and wherein said first end of said torsion spring is in contact with said handle portion of said first body member and said second end of said torsion spring is in contact with said handle portion of said second body member.

15. The hair holding device of claim 1 wherein said first and second body members further comprise handle portions that are squeezable by a user to release said hair gripping portions from the point at which said hair gripping portions are squeezed together by a user.

IX. EVIDENCE APPENDIX

NONE.

X. RELATED PROCEEDINGS APPENDIX

NONE.

3477257v1